

REMARKS

Attached hereto is a marked up version of the changes made to the specification and claims by the current amendment. The attached page is captioned **“Marked Up Version Showing Changes”**.

In the above Office Action, the “abstract of the disclosure” was objected to because there is no mention of Figure 16 in the section entitled “Description of the Drawings”. It is believed that this was intended as an objection to the “disclosure” rather than an objection to the “abstract of the disclosure”. Accordingly, a paragraph has been added describing Figure 16.

In the above Office Action, claim 9 was objected to as containing the word “connecting” rather than “generating”. This has been corrected.

Each of claims 20-23 was also rejected under Section 112 as being indefinite. Pursuant to the present amendment, these claims have either been cancelled or have been amended to recite a “fishing sinker” rather than a “method”. It is believed that with the present amendments, all of the above objections/rejections have been overcome and reconsideration is respectfully requested.

In the Office Action of August 1, 2001, claims 1-7, 10, 11 and 14-16 were rejected under Section 102(b) as being anticipated by Wohead Patent No. 3,670,447 and claims 1, 5-8, 10, 11, 13-15, 19, 20 and 23 were rejected under Section 102(b) as being anticipated by LaForce Patent No. 3,852,906. Various claims, including the remaining claims, were also rejected under Section 103 as being unpatentable over Wohead or LaForce or unpatentable over Wohead or LaForce in view of various secondary references. The primary references of Wohead and LaForce and the various secondary references have been carefully considered and amendments have been made to the claims which clearly overcome the above rejections and patentably distinguish the present claims from the prior art. Reconsideration of the allowability of the amended claims is respectfully requested in view of the following comments.

All of the claims presently in the application require, or have been amended to require, that the noise generating element comprise a “hollow member” and “one or more noise generating objects moveable freely within said hollow member”. This eliminates the LaForce patent from having any applicability to the present claims. Even if the element C of LaForce

could be considered as being a noise generating element as the Examiner contends, and which applicants dispute, such noise generating element does not include a “hollow member” or “one or more noise generating objects moveable freely within said hollow member”. Accordingly, all of the claims in their presently amended form are distinguishable from the LaForce patent, both individually and in combination with other secondary references.

With respect to the Wohead patent, Wohead discloses a non-snagging fishing device for use as a sinker which includes a pair of plastic hollow sections 13 and 14 which are joined together by a coupling means 15. The coupling means 15 includes a plug portion 19 for sealing the hollow tube 13 and a threaded projection 25 for mating with internal threads at the upper end of the hollow tube 14. A weighted portion 23 is connected at the outer distal end of the hollow tubular section 14. The hollow tubular portion 14 is designed to receive a plurality of weight elements such as lead shot 28.

The only independent claims in the present application include amended claim 1 and new claim 25. Both of these independent claims, and thus their respective dependent claims, are clearly distinguishable over Wohead both individually under Section 102 and in combination with other references under Section 103. First, each of independent claims 1 and 25 requires the sinker to comprise a “noise generating element”. There is no disclosure whatsoever in Wohead of such an element. The Examiner has taken the position that the lead shot elements 28 within the tubular element 14 comprise the “noise generating element”. Although the lead shot 28 would appear to be moveable to some extent relative to the tubular member 14, there is absolutely no disclosure in Wohead that such movement would generate any noise during use or that it is intended to generate noise during use. Thus, the position of the Examiner in the Office Action is purely conjecture. Unless there is some disclosure that the lead shot 28 would in fact generate noise within the tubular member 14 during use, it is not an anticipatory reference.

Secondly, independent claim 1 further requires the noise generating element to be connected with the weighted section “at said free end so that said weighted section is between said buoyant section and said noise generating element”, while independent claim 26 requires the noise generating element to be connected with the elongated body “at said free end so that the entirety of said weighted section is between said noise generating element and said line

connection end”. This is directly opposite to the structure shown in Wohead. In Wohead, the weighted portion 23 is positioned at, and defines, the free or distal end of the Wohead fishing device. Accordingly, even if it is assumed that the tubular member 14 and the lead shot 28 of Wohead are considered as the “noise generating element” (which applicants dispute), such element is positioned between the weighted portion 23 and the buoyant portion 13 of Wohead or between the weighted portion 23 and the line connection end 17 of Wohead.

Accordingly, the present claims are clearly distinguishable from Wohead under Section 102, even if the tubular member 14 and the lead shot 28 are considered to meet the language of the claims requiring a hollow member and one or more noise generating objects moveable freely within said hollow member, which applicants dispute.

The present claims are also distinguishable from Wohead under Section 103, both individually and in combination with other references. As discussed above, even if one considers the tube 14 and the lead shot 28 of Wohead to comprise a noise generating element, that element is not connected with the elongated body or the weighted section “at said free end” as required by the claims. Instead, in Wohead, the weighted portion 23 is positioned at the free end, with the tube 14 and lead shot 28 (the noise generating element as contended by the Examiner) between the weighted section 23 and the line connection end or the buoyant section. Thus, the claims define a structure opposite to that disclosed in the Wohead patent. The question then becomes whether it would have been obvious to a person skilled in the art to modify Wohead by reversing those elements in order to meet the language of the present claims. The answer is clearly “no”.

First, the invention of Wohead requires the weighted portion 23 to be at the distal or free end and the tube 14 and lead shot 28 to be positioned above it, between the weight 23 and the line connection end. This is confirmed in the Abstract of Disclosure in which the invention is characterized by an elongated tubular body having a flotation portion adjacent one end and the weight “concentrated adjacent the other end” so that it assumes a substantially upright position in the water. Further, the summary of the invention and the description of the preferred embodiments describe and disclose an elongated body with the weight concentrated at the end. Still further, all claims of the Wohead patent require a body portion formed by a tube with one

end of that tube being closed by a weight mounted in said end and with the other end including means for attaching the device to a fishing line. Thus, the claims all require the specific structure and weight orientation as disclosed in Wohead, namely, a structure with the weighted portion 23 at the distal end with the tube 14 and lead shot 28 above it. To somehow modify the structure of Wohead to reverse the position of the weight 23 and the tube 14 would be totally inconsistent with the clear teachings of the Wohead reference. The law is clear that any modification of a prior art reference which is inconsistent with the teachings of that reference is not an obvious modification.

Further, because the tubular portion 14 of Wohead is closed at both ends by the threaded connection at the end 24 and the weighted plug 23, the tube contains trapped air and is, to some extent, buoyant. If the position of the tube 14 and the weighted member 23 was reversed, the lower end of the device would include the tube 14 which would have some buoyant properties, thereby destabilizing the entire device or at least preventing the device from operating as it is intended, which is to concentrate all of the weight at the lower end so that the device assumes a substantially upright position in the water. The law is equally clear that if a proposed modification to the prior art reference would render that reference inoperable or not fully operable in the manner disclosed, such a modification is not obvious.

Accordingly, for the reasons discussed above, not only are the present claims distinguishable from Wohead under Section 102, they are also distinguishable over any modification of Wohead which would have the effect of reversing the portion of the weighted portion 23 and the tubular portion 14.

The various dependent claims define additional combinations and features of the present invention which further distinguish from Wohead both individually and in combination with other references. For example, dependent claims 8 and 19 require the weighted portion to be comprised of a molded metal and the noise generating element to be molded into the weighted portion. This is not shown to be the case in Wohead. In fact, because the tube 14 is constructed of plastic and the weight 23 is constructed of a material such as lead, it is highly unlikely that these are molded together.

Still further, dependent claims 9 and 20 require the fishing sinker to include an exterior coating covering substantially the entirety of the body and noise connecting element. The Examiner's position is that Tharp et al. discloses a fishing post which may be painted with different colors, etc., with the paint being considered a coating. This, however, does not include a "plastic seal coating" as recited in claim 9 or a "dip coating" as recited in claim 20. Because Wohead requires a structure in which the tubular section 14 needs to be disconnected from the connector 15 in order to add or reduce the number of lead shot 28, the coating of the entire exterior surface with either a dip coating or a plastic seal coating would not be functional.

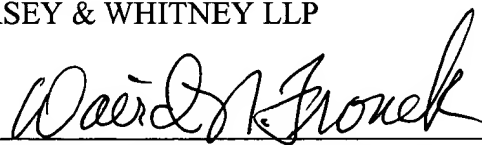
Still further, dependent claims 12 and 17 require the sinker to include a wire extending substantially through the entirety of the body. The Examiner rejects these claims in view of various secondary references which disclose a wire extending from a first end for line attachment. However, both claims 12 and 17 require a wire extending substantially through the "entirety of said body". Such a structure would not be functional with the device of Wohead since Wohead requires the tubular portion 14 to be disconnected. Thus, a modification which would attempt to add a wire to Wohead would simply be non-functional and would prevent the tubular portion from being removed. Further, there is no suggestion by the Examiner as to how this would be done while maintaining the buoyant tubular member of 13 in a sealed, airtight condition.

For all of the above reasons, and particularly in view of the amendments to the claims, the discussion of the prior art references and the distinctions between the present claims and such references, it is believed that the present claims are in condition for allowance and such action is respectfully requested.

Respectfully submitted,

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IN THE SPECIFICATION

Add the following paragraph on page 7, after the paragraph ending in line 9:

Figure 15 is a view, partially in section, of the noise generating element in the sinker of the present invention.

IN THE CLAIMS

Amend claims 1, 6, 8, 9, 12-14 and 18-21 as follows:

1. (Amended) A fishing sinker comprising:

an elongated body having a line connection end and a free end and having a buoyant section and a weighted section, said weighted section constructed of a weighted material having density greater than that of water and being positioned closer to said free end than said line connection end and

a noise generating element connected with said weighted section at said free end so that said weighted section is between said buoyant section and said noise generating element, said noise generating element comprising a hollow member and one or more noise generating objects moveable freely within said hollow member [body].

6. (Amended) The fishing sinker of claim [5] 1 wherein said noise generating element is connected at said free end and extends outwardly therefrom away from said line connection end.

8. (Amended) The fishing sinker of claim [7] 1 wherein said weighted portion is comprised of a molded metal and said noise generating element is molded into said weighted portion.

9. (Amended) The fishing sinker of claim 8 including an exterior plastic seal coating covering substantially the entirety of said body and noise [connecting] generating element.

12. (Amended) The fishing sinker of claim [11] 1 including a wire extending substantially through the entirety of said body wherein said wire has an end defining said line connection end.

13. (Amended) The fishing sinker of claim [11] 1 wherein said weighted portion includes a first weighted section at said free end and a second weighted section at said line connection end, wherein said buoyant portion is positioned between said first and second weighted sections and wherein said noise generating element is connected with said first weighted section.

14. (Amended) The fishing sinker of claim [11] 1 wherein said noise generating element extends outwardly from said weighted portion.

18. (Amended) The fishing sinker of claim 17 wherein said weighted portion includes a first weighted section at said free end and a second weighted section at said line connection end, wherein said buoyant portion is positioned between said first and second weighted sections and wherein said noise generating element is connected with said first weighted section.

19. (Amended) The fishing sinker of claim [11] 17 wherein said weighted portion is comprised of a molded metal and said noise generating element is molded into said weighted portion.

20. (Amended) The [method] fishing sinker of claim [19] 1 including an exterior dip coating covering substantially the entirety of said body and noise connecting element.

21. (Amended) The [method] fishing sinker of claim [19] 17 wherein said weighted portion is comprised of first and second weighted portions and wherein said first and second weighted portions are molded to opposite ends of said buoyant portion.

Add new claims 24-29 as follows:

24. (New) The fishing sinker of claim 1 wherein said hollow member is a closed hollow member.

25. (New) The fishing sinker of claim 1 wherein said hollow member is constructed of a material different than said weighted material.

26. (New) A fishing sinker comprising:

an elongated body having a line connection end and a free end, said body constructed at least in part of a solid weighted material having a density greater than that of water and

a noise generating element connected with said elongated body at said free end so that the entirety of said weighted section is between said noise generating element and said line connection end, said noise generating element comprising a hollow member and one or more noise generating objects moveable freely within said hollow member.

27. (New) The fishing sinker of claim 26 wherein said hollow member is a closed hollow member.

28. (New) The fishing sinker of claim 26 including an exterior dip coating covering substantially the entirety of said body and noise connecting element.

29. (New) The fishing sinker of claim 26 wherein said hollow member is constructed of a material different than said weighted material.

Cancel claims 5, 7, 10, 11, 22 and 23.